

REMARKS

Applicant wishes to thank the Examiner for the courtesies extended to the undersigned during the telephonic interview of October 7, 2002. Claims 53 and 70 are canceled, claims 50, 54, 60 and 66 are amended and claims 99-100 are added. Claims 50-52, 54-69, and 71-100 are pending in the present application. Claims 50, 53, 66, 70, 82, 84 and 92 stand rejected for anticipation by U.S. Patent No. 5,801,466 to Odagiri et al. Claims 51-52, 67-69, 71-75 and 94 stand rejected for obviousness over Odagiri in view of U.S. Patent No. 5,493,437 to Lebby et al. Claims 83, 91 and 93 stand rejected for obviousness over Odagiri in view of U.S. Patent No. 6,104,333 to Wood, Jr. et al. Claims 54-65, 76-81, 86, 88, 90, 96 and 98 stand rejected for obviousness over Neustein in view of Lebby. Claims 85, 87, 89, 95 and 97 stand rejected for obviousness over Neustein in view of Lebby and Wood, Jr.

Applicant respectfully traverses the rejections and urges allowance of the present application.

As discussed during the telephonic interview, Applicant hereby combines the limitation of previously pending claim 53 with limitations of claim 50 which now recites the communication circuitry comprises radio frequency identification device circuitry. Odagiri fails to disclose or suggest any RFID or radio frequency identification device teachings. As discussed during the telephonic interview, RFID refers to a specific class of devices and methodologies. Applicant hereby submits a web page which discusses RFID and radio frequency identification devices in general. It is clear that the portable telephone set of Odagiri fails to disclose or suggest the positively recited radio frequency identification

device circuitry of claim 50. Positively recited limitations of claim 50 are not shown or suggested in the art and claim 50 is allowable for at least this reason.

The claims which depend from independent claim 50 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

103 (b) 10 For example, claim 83, stands rejected under §103 over Wood, Jr. 35 U.S.C. §103(c) provides that subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), (g) of §102, shall not preclude patentability under §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. The Wood reference and the claimed invention were subject to an obligation of assignment to the same entity and the Wood reference qualifies as prior art under subsection (e) of §102. Accordingly, the Wood reference has been improperly utilized in support of the obviousness rejection. Applicant respectfully requests withdrawal of all obviousness rejections over Wood and allowance of such claims in the next Action. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 83 in the next Action.

8 Claim 54 recites a substrate having a support surface defined by a perimetral edge and an encapsulant elevationally over the support surface and the encapsulant and the substrate respectively define an *upper surface and a lower surface and have a thickness less than a smallest dimension of the perimetral edge and the encapsulant includes visibly perceptible indicia intermediate the upper surface and the lower surface.* Indicia 16 of

Neustein is identified in the Office Action as allegedly disclosing the claimed indicia. As clearly shown in Fig. 1, indicia 16 is provided upon a front or back of a credit card which fails to disclose or suggest the substrate and the encapsulant having the thickness less than the smallest dimension of the perimetral edge including visible perceptible indicia intermediate the upper surface and lower surface as defined in claim 54. Claim 54 recites limitations not shown or suggested in the art and claim 54 is allowable for at least this reason.

In addition, claim 54 stands rejected over Neustein in view of Lebby. Motivation is required to combine reference teachings in support of an obviousness rejection. Referring to MPEP §2143.01 (8th ed.), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by a combination of references unless there is some motivation in the art to support the combination. See *ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is stated on page 6 of the Office Action that it would have been obvious to

combine Lebby with Neustein because Neustein suggests molding a circuit to give appearance of regular credit cards and Lebby teaches encapsulation of communication circuitry molded in the form of a credit card pager in order to provide a ruggedized structure. Applicant disagrees with the combination of reference teachings in support of the rejection of claim 54. Referring to the teachings of Neustein at column 3, lines 46-51, column 4, lines 60-68, column 5, lines 1-4, column 12, line 66 - column 13, line 12 and Figs. 1-1c, 4 and 5, various housing configurations are described in detail. As set forth in the previous Office Action response, there is absolutely no evidence of record that the housings of Neustein are inadequate or that one of ordinary skill in the art would be concerned with providing a more ruggedized structure. There is absolutely no evidence of record that a combination of reference teachings of Lebby with Neustein would result in a housing having a more ruggedized structure.

The conclusory statements of the Office Action fail to establish that one would be motivated to combine the teachings of Lebby with the teachings of Neustein. The Federal Circuit recently discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual

to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references can not be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence of motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office can not rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 54 is improper without the proper motivation and Applicants respectfully request allowance of claim 54 in the next action.

Further, the alleged motivational rationale citing Lebby teachings regarding communication circuitry molded in the form of a credit card pager are redundant inasmuch as Neustein *already discloses credit card packaging constructions* at least as contained within the passages and teachings of Neustein identified above. The alleged motivational rationale is redundant and there is absolutely no evidence to support the assertions of the Office Action. The rejection of claim 54 is improper for at least reason.

The claims which depend from independent claim 54 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 85, the obviousness is improper in view of 35 U.S.C. §103(c).

Applicant requests allowance of such claim in the next Action.

Claim 59 recites a wireless communication device comprising, in part, communication circuitry and an encapsulant configured to *encapsulate and contact* at least a portion of the communication circuitry. Claim 59 is patentable over the prior art of record.

Page 6 of the Office Action correctly states that Neustein does not disclose an encapsulant configured to encapsulate and contact at least a portion of the communication circuitry. It is thereafter stated that Lebby discloses encapsulation of communication circuitry relying upon teachings in column 5, lines 13-26 of Lebby. Such teachings fails to disclose or suggest positively recited encapsulant configured to *encapsulate and contact* at least a portion of communication circuitry configured to communicate wireless signals as required by claim 59. As described in the previous Office Action response, casing 11 includes over molding portions 22, 23 which are described to encapsulate inner components of pager 10. However, nowhere is it provided that casing 11, portions 22, 23 or other encapsulant structures of Lebby contact communication circuitry configured to communicate wireless signals as positively defined in claim 59. The Examiner failed to identify any specific teachings relied upon as allegedly disclosing such limitations. Positively recited limitations of claim 59 are not shown or suggested in the art and claim 59 is allowable for at least this reason. There is no motivation to support the 103 and claim

59 is allowable.

The claims which depend from independent claim 59 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 60 recites the at least one side surface of the encapsulant has a thickness less than 100 mils and visibly perceptible information thereon. Page 6 of the Office Action identifies indicia 16 of Neustein as allegedly disclosing the claimed information. The indicia 16 of Neustein fails to disclose or suggest a side surface of an *encapsulant having visibly perceptible information and a thickness less than about 100 mils* as recited in claim 60. Claim 60 recites limitations not shown or suggested in the art and claim 60 is allowable for at least this additional reason.

Referring to claim 87, the obviousness is improper in view of 35 U.S.C. §103(c).

Applicant requests allowance of such claim in the next Action.

Claim 62 recites a housing including an upper surface and a lower surface *which define a housing thickness of less than about 100 mils intermediate the lower surface and the upper surface*, and the housing has visibly perceptible indicia thereon intermediate the *upper surface and the lower surface*. The indicia 16 of Neustein fails to disclose or suggest visibly perceptible indicia on a housing having a thickness of less than 100 mils intermediate an upper surface and lower surface as claimed. Indicia 16 is provided upon either a front or back of a credit card as illustrated in Fig. 1 which fails to disclose or suggest limitations of claim 62. Positively recited limitations of claim 62 are not shown or suggested in the art and claim 62 is allowable for at least this reason. There is no

motivation to support the 103 rejection and claim 62 is allowable.

The claims which depend from independent claim 62 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 89, the obviousness is improper in view of 35 U.S.C. §103(c). Applicant requests allowance of such claim in the next Action.

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Claim 65 recites a radio frequency identification device comprising, in part, radio frequency identification device circuitry and an encapsulant contacting at least portions of the support surface, the radio frequency identification device circuitry, the power source and the antenna, and the at least one side surface having a dimension less than smallest dimensions of the upper and lower surfaces, and the at least one side surface including visibly perceptible indicia. The prior art of record fails to disclose or suggest RFID teachings, radio frequency identification device or radio frequency identification device circuitry teachings. Claim 65 is allowable for at least this reason.

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In addition, the identified indicia 16 of Neustein upon a front or back of a credit card fails to disclose or suggest the positively claimed encapsulant having at least one side surface having a dimension less than smallest dimensions of upper and lower surfaces and the at least one side surface including visibly perceptible indicia as positively recited.

Positively recited limitations of claim 65 are not shown or suggested in the art and claim

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65 is allowable for at least this reason.

Further, there is no motivation to support the combination of Neustein with Lebby. The 103 rejection of claim 65 is improper for at least this additional reason.

Claim 66 recites a method of forming a wireless communication device comprising providing communication circuitry comprising providing radio frequency identification device circuitry. Odagiri discloses a *portable telephone set* and in no fair interpretation discloses or suggests provision of radio frequency identification device circuitry as recited in claim 66. Applicant has failed to uncover any RFID or radio frequency identification device teachings within in Odagiri and claim 66 is allowable for at least this reason.

The claims which depend from independent claim 66 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 91, the obviousness is improper in view of 35 U.S.C. §103(c). Applicant requests allowance of such claim in the next Action.

Claim 71 stands rejected over Odagiri in view of Lebby. There is no motivation to combine the teachings of Lebby with the teachings of Odagiri. It is stated on page 5 of the Office Action that the combination is appropriate because Odagiri suggests a housing containing a printed circuit board associated with communication circuitry and Lebby teaches the housing comprises an encapsulant which contacts the communication circuitry and one surface has a dimension less than about 100 mils to provide a smaller and ruggedized structure. One of ordinary skill in the art concerned with portable telephone sets would not look to Lebby regarding a credit card pager for meaningful teachings. Significant redesign or construction would be required to implement the proposed modification. Further, Odagiri teaches away from such a combination inasmuch as Odagiri utilizes a vibrator attaching structure, microphones, speakers, and other considerably large

sized elements for which the teachings of Lebby would be inapplicable. The Examiner has improperly utilized Applicant's disclosure as a roadmap to combine the reference teachings and the rejection of claim 71 is improper for at least this additional reason.

The claims which depend from independent claim 71 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 93, the obviousness is improper in view of 35 U.S.C. §103(c). Applicant requests allowance of such claim in the next Action.

Claim 76 recites encapsulating at least a portion of the communication circuitry with an encapsulant which *contacts at least the encapsulated portion of the communication circuitry*. Neustein and Lebby alone or in combination fail to disclose or suggest an encapsulant contacting communication circuitry. The Office Action fails to identify any teachings which disclose such limitation of claim 76. The identified teachings in the Office Action of Lebby regarding casing 11 fails to disclose or suggest the claimed contacting. Claim 76 recites limitations not shown or suggested in the prior art of record and claim 76 is allowable for at least this reason.

In addition, there is no motivation to combine the teachings of Lebby with the teachings of Neustein. The 103 rejection is improper for at least this additional reason.

The claims which depend from independent claim 76 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 95, the obviousness is improper in view of 35 U.S.C. §103(c).

Applicant requests allowance of such claim in the next Action.

2 Claim 79 recites a method of forming a radio frequency identification device comprising, in part, providing radio frequency identification device circuitry, providing a housing including at least one side surface having a dimension less than about 100 mils and providing visibly perceptible indicia on the at least one side surface. Claim 79 recites limitations not shown or suggested in the prior art of record and claim 79 is allowable. For example, Neustein and Lebby fail to disclose or suggest any RFID or radio frequency identification device teachings. The prior art fails to disclose or suggest the provision of radio frequency identification device circuitry and claim 79 is allowable for at least this reason. Further, indicia 16 of Neustein fails to disclose or suggest at least one side surface having a dimension less than 100 mils and providing visibly perceptible indicia on the at least one side surface as positively recited. Claim 79 recites numerous limitations not shown or suggested in the prior art of record and claim 79 is allowable for at least this reason.

There is no motivation to combine the teachings of Neustein with the teachings of Lebby and the obviousness rejection of claim 79 is improper for at least this additional reason.

The claims which depend from independent claim 79 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 97, the obviousness is improper in view of 35 U.S.C. §103(c). Applicant requests allowance of such claim in the next Action.

Claim 82 recites a method of forming a radio frequency identification device comprising, in part, providing radio frequency identification device circuitry, providing a housing including an upper surface, a lower surface and at least one side surface, the at least one side surface having a dimension less than smallest dimensions of the upper surface and the lower surface, and providing visibly perceptible indicia on the at least one side surface. Claim 82 recites patentable subject matter.

The Odagiri reference disclosing portable telephone sets fails to disclose or suggest any radio frequency identification device circuitry or RFID teachings. Claim 82 recites limitations not shown or suggested in the prior art of record and claim 82 is allowable for at least this reason.

Applicant submits a Supplemental Information Disclosure Statement herewith.

Applicant hereby adds new claims 99-100. New claim 99 includes limitations of previously pending claims 50 and 83. Claim 100 includes limitations of previously pending claims 66 and 91. New claims 99 and 100 are believed to be allowable over the prior art inasmuch as such claims were previously improperly rejected under 35 U.S.C. §103 over Wood, Jr.


Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Serial No. 09/524,804

Respectfully submitted,

Dated: 10/21/02

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Inventor Mark E. Tuttle
Assignee Micron Technology, Inc.
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VERSION WITH MARKINGS TO SHOW CHANGES MADE ACCOMPANYING
RESPONSE TO JUNE 19, 2002 OFFICE ACTION

In the Claims

Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

50. (Amended) A wireless communication device comprising:

a housing including an upper surface, a lower surface, and at least one side
intermediate the upper surface and the lower surface and having a dimension less than
smallest dimensions of the upper surface and the lower surface, and the at least one side
surface having visibly perceptible indicia thereon; and

communication circuitry within the housing and the communication circuitry being
configured to communicate wireless signals; and

wherein the communication circuitry comprises radio frequency identification device
circuitry.

54. (Amended) A wireless communication device comprising:

a substrate having a support surface defined by ~~at least one~~ a perimetral edge;

communication circuitry elevationally over the support surface of the substrate and

configured to communicate wireless signals; and

an encapsulant elevationally over the support surface and configured to encapsulate at least portions of the support surface of the substrate and the communication circuitry, and wherein the encapsulant and the substrate respectively define an upper surface and a lower surface and have a thickness less than a smallest dimension of the ~~at least one~~ perimetral edge, and the encapsulant includes visibly perceptible indicia intermediate the upper surface and the lower surface.

60. (Amended) The device according to claim 59 wherein the at least one side surface of the encapsulant has a thickness less than about 100 mils.

66. (Amended) A method of forming a wireless communication device comprising:

providing communication circuitry configured to communicate wireless signals;

providing a housing including an upper surface, a lower surface and at least one side surface about the communication circuitry, the at least one side surface has a dimension less than smallest dimensions of the upper surface and the lower surface; and

providing visibly perceptible indicia on the at least one side surface; and

wherein the providing communication circuitry comprises providing radio frequency identification device circuitry.

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